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EXAMINER

DESAI, RACHNA SINGH

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FERNANDO INCERTIS CARRO

Appeal 2007-2759
Application 09/892,399
Technology Center 2100

Decided: March 17, 2008

Before HOWARD B. BLANKENSHIP, ALLEN R. MACDONALD, and
JAY P. LUCAS, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-10, 18-25, and 31-38. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Representative claim 1 reads as follows:

1. A method of creating a geographic link from an electronic document to a physical document for locating, on the physical document, an item referenced in the electronic document, comprising the steps of:

defining the referenced item in the electronic document, said electronic document not being derived from the physical document;

determining geographic coordinates of the referenced item;

defining the geographic link to the physical document; and

encoding the geographic coordinates in the geographic link.

The Examiner relies on the following references as evidence of unpatentability.

Thompson	5,986,401	Nov. 16, 1999
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Musk	6,148,260	Nov. 14, 2000
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Robinson “*A Framework for Interacting with Paper*”, Eurographics (1997), Volume 16, Number 3, *available at* <http://www.cl.cam.ac.uk/Research/Origami/Origami1997c/index.html>, pages 1-9.

Claims 1-4, 7, 8, and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Robinson and Musk.

Claims 5, 6, 9, 18-25, and 31-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Robinson, Musk, and Thompson.

Claims 1, 18, and 31 are independent.

Claims 11-17 and 26-30 have been canceled.

Instant claim 1 recites a method of creating a “geographic link” from an electronic document to a physical document for locating, on the physical document, an item referenced in the electronic document. The steps include defining the referenced item in the electronic document, with the electronic document “not being derived” from the physical document, determining geographic coordinates of the referenced item, and defining “the geographic link” to the physical document.

A “geographic link” from an electronic to a physical document has, in essence, no meaning when the claim is read in isolation. The Specification indicates, however, that “geographic links” are a form of hyperlink that comprise encoded geographic or cartographic coordinates of the locations referenced in the electronic document. The geographic links are defined in the form of an extension of HTML (Hyper-Text Markup Language), with a syntax that includes a URL (Uniform Resource Locator) hyperlink, Latitude, Longitude, and Location Name. (*See Spec. 23: 1-11.*)

In response to the § 103(a) rejection of claim 1 over Robinson and Musk, Appellant submits that Robinson fails to show the negative limitation of the “electronic document not being derived from the physical document.” The statement of the rejection relies (Ans. 4) on § 4.1 of Robinson for the teaching, with the Examiner providing further explanation at pages 20 through 22 of the Answer.

Even assuming that Robinson teaches that the electronic document (e.g., image of an active document stored in the registry; § 3) is *not* derived

from the physical document (e.g., printed document described in §§ 4.2 and 4.3), we would still be constrained to agree with Appellant that the rejection fails to show prima facie obviousness of the subject matter of instant claim 1.

The rejection does not provide a convincing rationale in support of why combining the “DigitalDesk” system described by Robinson with a user interface having an electronic map (Musk Fig. 2) would result in the invention of claim 1. Musk does describe geographic coordinates that relate to an electronically displayed item (e.g., columns 3 and 4). However, there is no persuasive explanation as to why the artisan would have used a hyperlink comprising encoded geographic coordinates of the locations referenced in the electronic document for linking an electronic and a physical document (e.g., a map) in the DigitalDesk system.

The rejection suggests that Robinson teaches using absolute coordinates to link electronic and physical versions of a document. (Ans. 4.) *See also* Robinson § 4.2, describing registration marks on a printed document. The rejection then goes on, however, to suggest that Musk’s teachings that relate to geographic coordinates in an *electronic version* of a map would apply to Robinson’s system in defining a link between an electronic and a physical document. Musk’s teachings, however, appear to relate to the claim 1 step of “determining geographic coordinates of the referenced item” -- an item referenced in an electronic document -- but not to defining a link between an electronic and a physical document, which Robinson already does.

We thus agree with Appellant that the rejection of claim 1 fails to account for, at the least, “defining the geographic link to the physical document” and “encoding the geographic coordinates in the geographic link” as required by the claim.

Each of independent claims 18 and 31 is drawn to locating items on a physical document by calibrating an opto-touch foil aligned on a physical document, and which, *inter alia*, relates geographical coordinates in an electronic document to corresponding coordinates in a physical document. Thompson, applied in further combination with Robinson and Musk, teaches an organic light emitting device (OLED) but does not remedy the above-noted deficiencies we find in Robinson and Musk.

The decision of the Examiner is reversed.

REVERSED

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